REMARKS

Claims 1-11 are pending. Claims 1 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Minowa et al. (6,243,637) in view of Narita (5,241,477). Claims 2-5 and 7-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Minowa et al. in view of Narita and Vilim et al. (5,745,382). No amendments have been made to the claims.

Rejection of Independent Claims 1, 6 and 11:

Claim 1 requires (in part, with emphasis added):

> determining the first derivative with respect to time of at least a portion of the off-going clutch pressure command; and
>
> determining when the on-coming clutch gained torque capacity using the first derivative.

THE EXAMINER HAS NOT SHOWN THAT THESE ELEMENTS ARE TAUGHT ANYWHERE IN THE PRIOR ART. Applicant has repeatedly pointed out that the prior art cited by the Examiner, alone or in combination, does not teach the above elements and limitations.

Applicant respectfully requests that the Examiner identify where in the prior art these elements and limitations are shown. Until the actual, supportable, basis of the Examiner's rejection is made clear, Applicant is unable to prosecute the application.

In spite of the failures of the prior art, the Examiner has maintained the rejection of Claims 1, 6, and 11. The specific areas of the Narita and Minowa patents to which the Examiner has pointed do not disclose the above elements and limitations. It appears that the Examiner is stating that the existence of a "first derivative technique" (see Advisory Action mailed December 11, 2008, paragraph 2) renders obvious any use of a first derivative of any variable; and further renders obvious any application of that first derivative to any method,

method step, or structure associated therewith. If this is indeed the Examiner's position, Applicant requests that the Examiner make this position explicit.

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." (Emphasis added). The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP § 2142.

Therefore, because elements of Applicant's invention have not been identified anywhere in the prior art, the Examiner cannot support a *prima facie* case of obviousness, and the obviousness rejection is overcome.

Claims 6 and 11 contain similar elements and limitations. Accordingly, the analysis presented for Claim 1 also applies to Claims 6 and 11. Therefore, the rejection of Claims 6 and 11 is also improper, and the rejections thereof are overcome for at least this reason. All remaining claims depend from Claims 1 and 6, and the rejections thereof are similarly overcome for at least this reason.

In order to clarify the record for appeal, if the Examiner maintains that the 35 U.S.C. 103 rejection of Applicant's claims are supported, Applicant's respectfully request that the Examiner explicitly show where in Narita, Minowa, Vilim, or some other piece of prior art there is a disclosure of "determining the first derivative with respect to time of at least a portion of the off-going clutch pressure command; and determining when the on-coming clutch gained torque capacity using the first derivative." Until the Examiner comes forth with a *prima facie* case, Applicant is not required, and is unable, to argue whether or not the prior art renders any of Applicant's claims obvious.

Further reasons for the impropriety of the rejections of Claims 1-11 are present. However, because the rejections are clearly improper for the reasons provided above, further analysis is not necessary at this time.

CONCLUSION

This reply is believed to be fully responsive to the Final Office Action mailed October 28, 2008. The remarks are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted,

Matthew D. Whitton

By _____
Reid M. DeManche
Reg. No. 61,559

Date: 1/22/09

QUINN LAW GROUP, PLLC
39555 Orchard Hill Place, Ste. 520
Novi, Michigan 48375
Phone: 248-380-9300
Fax: 248-380-8968

On behalf of:

GENERAL MOTORS CORPORATION
Legal Staff Mail Code 482-C23-B21
P.O. Box 300
Detroit, Michigan 48265-3000